

In re: Cho  
Serial No. 10/727,031  
Filed: December 2, 2003  
Page 10 of 13

### **REMARKS**

Applicant responds herein to each of the issues raised in the Final Action. Applicant appreciates the thorough examination of the present application and the indication of allowable subject matter in Claims 9, 21- 22 and 30-31. Applicant submits the present application is in form for allowance for the reasons discussed below.

#### **The Information Disclosure Statement (IDS) Mailed December 2, 2003:**

Applicant appreciates the Examiner's returning copies of the three PTO-1449 forms submitted with IDSs in this matter with the Examiner's signature thereon. However, in the interests of ensuring a clear record in this matter, Applicant again requests a copy of the PTO-1449 from the IDS mailed December 2, 2003 that is signed **and** has the Examiner's initials next to each of the listed references so that it will be clear all the references have been considered. The Examiner's initials are included on the other two PTO-1449s already.

#### **The Certified Translation of the Priority Document:**

As discussed below, the Examiner has required a certified translation of the priority application as a condition to affording this application the benefit of the earlier filing date. Accordingly, the requested certified copy of the translation of the priority application is submitted herewith.

#### **The Prior Art Rejections:**

Claims 1-8, 10-20 and 23-29 stand rejected as obvious under 35 U.S.C. § 103 in light of United States Patent No. 6,909,332 to Yin *et al.* ("Yin") in view of United States Patent No. 6,836,192 to Yang *et al.* ("Yang") and further in view of United States Patent No. 5,648,744 to Prakash *et al.* ("Prakash"). Final Action, p. 2. These rejections appear substantially identical to those in the previous Office Action. Accordingly, to expedite the Examiner's reconsideration of the rejections, Applicant will only address newly raised issues in this response. However, to ensure that this submission is considered fully responsive to the Final Action, Applicant's previous amendment, mailed September 29, 2005, is incorporated

by reference herein in its entirety. Applicant respectfully submits that the rejected claims are allowable at least for the reasons discussed herein and in the previous amendment.

As an initial matter, Applicant notes that the primary reference Yin, was filed August 12, 2003 while the claims of the present application are fully supported by the Korean priority document, which was filed January 30, 2003 (see, for example, figures of the certified copy filed with this application). The Final Action states that the present application will not be provided the benefit of the earlier date without submission of an English language translation of the priority application to perfect the claim for priority. Final Action, pp. 4-5. Applicant submits that the translation submitted herewith meets the requirement and the present application is entitled to the benefit of the priority date of the earlier filed Korean application. Accordingly, Yin only qualifies as prior art to the extent the matter relied on in the rejection is found in the earlier filed Provisional Application No. 60/403,457 ("the '457 application"). Based on the Applicant's review of a copy of the '457 application obtained from the USPTO Public PAIR system, Figures 14A-14C of Yin and the accompanying description are not found in the '457 application. Accordingly, the rejections of Claims 1-8, 10-20 and 23-29 should be withdrawn at least as Yin, as applied in the present rejections, does not qualify as prior art against the present application.

The Final Action further appears to indicate that Figure 27 of the Yin provisional will be applied for the same teachings as Figures 14A-14C of Yin responsive to Applicant's perfecting of the priority claim herein. Final Action, p. 4. As an initial matter, Applicant notes that the present rejections should be withdrawn even if Yin could be applied as prior art for the reasons set forth in the Applicant's previous Amendment. However, the insufficiency of the motivation for the combination relied on in the rejections is even more pronounced when viewed from the perspective of Figure 27 of the Yin provisional.

As described in the Yin provisional, Figure 27 "illustrates a delay amplifier the differential outputs of which may be coupled to the switched capacitor network 2600. The amplifier 2402, 2404 can be tuned to provide an ideal output response at the clock frequency to be sure that the output response is reasonably flat between the delay capacitance extremes." Yin Provisional, p. 21, lines 1-4. The discussed delay is "the requisite delay by which the

skew between clock and data" is adjusted in the data stream demultiplexer. Yin Provisional, p. 21, lines 5-10, Title. Thus, the capacitor network in Figure 27 of the Yin Provisional is to set a delay for use with processing a data stream. As such, it not only is not described as used with a voltage controlled oscillator (VCO), it is not even described as used for calibrating a frequency.

The rejections based on Yin, at most, only attempt to address modifications to a tuning circuit for the VCO illustrated in Figures 14A-14C of Yin. In contrast, to combine the secondary references relied on in the rejections with the Yin Provisional application, the rejection is required to establish, from the references, a motivation to look to a delay circuit and to adapt that circuit to tune a frequency of a VCO. In addition, a motivation would also have to be found for further modifying the circuit of the Yin Provisional, coupled to a VCO, to arrive at the recitations of the rejected claims. Applicant submits there is clearly no basis to assert that the Yin Provisional can be combined with the secondary references to render the claims of the present application. Accordingly, should the Examiner consider applying the Yin provisional in place of Yin in a subsequent action in this matter, Applicant respectfully submits that the rejected claims are also patentable over the Yin provisional and the secondary references for at least these additional reasons.

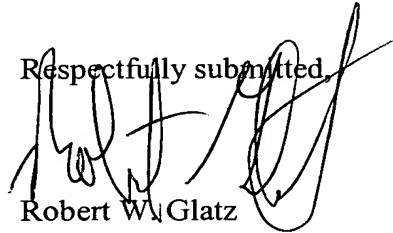
The Final Action also indicates that the Applicant's previous arguments regarding selection of capacitance values are not persuasive absent showing of an unexpected result. Final Action, p. 5. However, as more fully explained in the Applicant's previous amendment, the selection of these values in the present application is with respect to a combined varactor and capacitor structure, which may affect the selection of component values. As described for some embodiments of the present invention, the paired switching of a capacitor and varactor in the circuit may provide for improved performance in gain control over prior art systems. In other words, it is the changing of both a varactor and a capacitor value that is used to limit gain variation, and no such combination of switchable components is disclosed or suggested by any of the cited references. Thus, the selection of values is not merely a "result effective variable." Final Action, p. 5.

In re: Cho  
Serial No. 10/727,031  
Filed: December 2, 2003  
Page 13 of 13

### CONCLUSION

Applicant respectfully submits that, for the reasons discussed above, the references cited in the present rejections do not disclose or suggest the present invention as claimed. Accordingly, Applicant respectfully requests allowance of all the pending claims and passing this application to issue.

Respectfully submitted,

  
Robert W. Glatz  
Registration No. 36,811

Myers Bigel Sibley & Sajovec  
P.O. Box 37428  
Raleigh, NC 27627  
(919) 854-1400 phone  
(919) 854-1401 fax

#### Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on February 9, 2006.

  
Carey Gregory

484376